

REMARKS

The Office Action mailed February 18, 2009 has been received and reviewed. Each of claims 1, 12, 15, 24, 27 and 37 stands rejected. Claims 1, 12, 15, 24, 27 and 37 have been amended herein. Care has been exercised to introduce no new subject matter. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

Objections to the Claims

Claims 12 and 37 are objected to for reciting “generating visual cues corresponding to the data not currently available.” As suggested by the Examiner, “the data” has been changed to “data.” Applicants respectfully request that the objections to claims 12 and 37 be withdrawn.

Rejections based on 35 U.S.C. § 112

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 24 is rejected because “wherein displaying the merged result includes” lacks proper antecedent basis. Claim 24 has been amended to recite “wherein generating the merged result includes.” “Generating the merged result” is recited in claim 15, on which claim 24 depends.

Applicants respectfully submit that this amendment overcomes the 35 U.S.C. § 112, second paragraph, rejection to dependent claims 24. Applicants respectfully request that the 35 U.S.C. 112 rejection of claim 24 be withdrawn.

Rejections based on 35 U.S.C. § 103

A. Authority

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere*, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the

hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant’s disclosure must be put aside in reaching this determination [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. Moreover, the Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness.”” MPEP § 2142 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

B. Goel in view of Kirsch, Bloch, and Walters

Claims 1, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goel et al. (U.S. Patent No. 7,130,841, hereinafter the “Goel reference”) in view of Kirsch (U.S. Patent No. 7,031,954, hereinafter the “Kirsch reference”), Bloch et al. (U.S. Publication No. 2003/0158947, hereinafter the “Bloch reference”) and Walters et al. (U.S. Patent No. 7,216,115, hereinafter the “Walters reference”). Claims 1, 15, and 27 have been amended to more clearly set forth the claimed subject matter. As the asserted combination of references fails

to disclose all of the elements set forth in the amended claims, Applicants respectfully traverse these rejections as hereinafter set forth.

Amended independent claim 1 sets forth a method for managing data available for access on a computer network having three or more computing devices in communication. The method comprises obtaining, at a host computing device associated with a user, a first user request to identify data corresponding to a set of criteria on both the host computing device and at least one network computing device and merging the results to generate a first user result. The method further comprises obtaining a second user result identifying data on the host computing device or on a network device and, while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request. Additionally, the method comprises generating a recalled result portion by recalling the portion of the first user result containing data located on the one computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the one unavailable computing device, thus allowing the stored first user result for a currently unavailable network computing device to substitute for the second user request search of that same device. The method further comprises generating a merged result by merging the substituted result and the second user result. Thus, it is as if the currently unavailable network computing device were available at the time the second user request is made.

Neither the Goel reference, the Kirsch reference, the Bloch reference, nor the Walters reference describe or suggest, either alone or in combination, all of the steps in the method of claim 1, in particular the step of "while still in communication with the computer

network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.” The Goel reference describes performing a search for both local and remote electronic content in response to a single user query in which the local result and remote result are amalgamated into a single result and displayed. The Goel reference does not describe conducting a second search or determining that at least one network computing device is unavailable to receive a query. The Goel reference also does not describe while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.

The Kirsch reference describes an electronic document retrieval system and method in which each user is assigned a user identification number. Through the use of URLs or pointers, each document to which a particular user has access is associated with that user’s user identification number. The Kirsch reference is cited for describing a unique security ID associated with each user and verifying the authorization of users to access data. The Kirsch reference, however, does not describe conducting a second search or determining that at least one network computing device is unavailable to receive a query. The Kirsch reference also fails to describe or suggest while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.

The Bloch reference describes a method of enabling online and offline operation of a software application. In the method described in the Bloch reference, when a local client is connected to a computer network, results of data requests sent from a local application to a

remote data source are cached in a local data store. When the local client is not connected to the computer network, information requests are run against the cached information stored locally rather than the remote data storage location in the network. The Bloch reference does not, however, disclose while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.

While the Bloch reference does disclose accessing local data when a remote source is unavailable, the local client in the Bloch reference is not connected to the computer network when the local client determines the remote source is unavailable. Rather, it is the local client that is disconnected from the network. In the method of claim 1, the host computing device associated with a user is still in communication with the computer network when it is determined that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request. Because the computer network described in claim 1 includes three or more computing devices, when it is determined that one computing device in the network is unavailable, the host computing device associated with the user remains in communication with at least one other computing device. In the method described in the Bloch reference, the local client computer is no longer in communication with the computer network when the local data store is accessed instead of the remote data store.

The Walters reference describes an apparatus and method for simultaneously displaying both record names and the associated files that result from a database search conducted by a user. The method described in the Walters reference does combine the results of prior searches with the same terms or keywords with subsequent search records, but this

combination of search records is done to avoid performing a new Boolean search or to supplement the results of a standard Boolean search (col. 4, lines 24-31). Applicants' method substitutes previous search results returned for a particular network computing device for current search results for the device because the device is currently unavailable and unable to be searched. The Walters reference also does not describe or suggest while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.

Neither the Goel reference, the Kirsch reference, the Bloch reference, nor the Walters reference teach the method step disclosed by Applicants and discussed above – while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request. Because the asserted combination of the Goel, Kirsch, Bloch, and Walters references fails to disclose all of the elements set forth in amended independent claim 1, Applicants respectfully traverse this rejection.

Amended independent claim 15 sets forth a method for managing data available for access on a computer network having three or more computing devices, the method comprising obtaining a first user request to identify content that corresponds to a set of criteria, the content being stored on the two or more computing devices, wherein one of the three computing devices is a local device. The method further comprises automatically querying the three or more computing devices to determine locations associated with the user's unique security ID and verifying the authorization of the user to access data from these locations that correspond to the first user request. The method further comprises performing a second user

search and obtaining a second user result identifying data stored on one or more available computing devices in the network that corresponds to the search and also matches the user's unique security ID. The method also comprises while still in communication with the computer network, determining that one computing device in the network that was previously searched as a result of the first user request is not available to identify data corresponding to the second user request. Additionally, the method comprises generating a recalled result portion by recalling the portion of the first user result containing data located on the one computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the one unavailable computing device, thus allowing the stored first user result to substitute for a search result from a currently unavailable network computing device. The method further comprises generating a merged result by merging the second user result and the substituted result. Thus, it is as if the currently unavailable network computing device were available at the time the second user request is made.

As discussed in greater detail above, neither the Goel, Kirsch, Bloch, nor Walters references teaches or suggests the method steps disclosed by Applicants and described above, specifically "while still in communication with the computer network, determining that one of the three or more computing devices previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request." Because the asserted combination of the Goel, Kirsch, Bloch, and Walters references fails to describe all of the limitations set forth in amended independent claim 15, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

Amended independent claim 27 sets forth a method for managing data available for access on a computer network having a computing device directly associated with a user and at least two remote computing devices, the method comprising obtaining, by the computing device associated with the user, a first user request to identify data that corresponds to a set of criteria, the data being stored on the devices in the computer network. The method further comprises obtaining an identification of locally stored data that matches the first user request criteria that the user is authorized to access according to the user's unique security ID. The method further comprises transmitting the first user request from the computing device associated with the user to the at least two remote network computing device and combining the local and remote results into a first user result. The method further comprises performing a similar second user search and obtaining a second user result. The method also comprises while still in communication with the computer network, determining that one remote computing device in the network that was previously searched as a result of the first user request is not available to identify data corresponding to the second user search. Additionally, the method comprises generating a recalled result portion by recalling, by the computing device directly associated with the user, the portion of the first user result containing data located on the one remote computing device that is unavailable during the second user request. The method further comprises generating a substituted result by substituting the recalled result portion for results from the second user request of the one unavailable remote computing device, thus allowing the stored first user result to substitute for a search result from a currently unavailable remote network computing device. The method further comprises generating a merged result by merging the substituted result and the second user result. Thus, it is as if the currently

unavailable remote network computing device were available at the time the second user request is made.

As discussed in greater detail above, neither the Goel, Kirsch, Bloch, nor Walters references teach or suggest the method steps disclosed by Applicants and described above – specifically “while still in communication with the computer network, determining, by the computing device directly associated with the user, that one remote computing device that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request.” Because the asserted combination of the Goel, Kirsch, Bloch, and Walters references fails to describe all of the limitations set forth in amended independent claim 27, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

In summary, because independent claims 1, 15, and 27 each recite at least one method steps not described or suggested by any of the cited references, Applicants respectfully traverse these 35 U.S.C. § 103(a) rejections.

C. Goel in view of Kirsch, Block, Walters, and Smith

Claims 12, 24 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goel, Kirsch, Bloch and Walters in view of Smith (U.S. Publication No. 2002/0059163, hereinafter the “Smith reference”). Claims 12, 24, and 37 depend directly from claims 1, 15, and 27, respectively. Because independent claims 1, 15, and 27 are believed to be in condition for allowance as discussed above, and because the Smith reference does not describe or suggest the steps of claims 1, 15, and 27 that the Goel, Kirsch, Bloch, and Walters references fail to describe or suggest, Applicants respectfully traverse these rejections and submit that amended claims 12, 24, and 37 are in condition for allowance.

The Smith reference describes searching information based upon search criteria, wherein search results are displayed and results that are not available may be flagged as unavailable. The Smith reference, however, does not describe or suggest "while still in communication with the computer network, determining that one computing device in the computer network that was previously searched as a result of the first user request is unavailable to identify data corresponding to the second user request."

Neither the Goel, Kirsch, Bloch, Walters, nor Smith references describe or suggest all elements of the methods of dependent claims 12, 24, and 37. Because the asserted combination of the Goel, Kirsch, Bloch, Walters, and Smith references fails to describe all of the limitations of dependent claims 12, 24, and 37, Applicants respectfully traverse this 35 U.S.C. § 103(a) rejection.

CONCLUSION

For at least the reasons stated above, claims 1, 12, 15, 24, 27 and 37 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or cduncan@shb.com (such communication via email is herein expressly granted) – to resolve the same.

The fees for a one-month extension of time and for a Request for Continued Examination are submitted herewith. It is believed that no additional fee is due, however, the Commissioner is hereby authorized to charge any amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

/CHRISTOPHER S. DUNCAN/

Christopher S. Duncan
Reg. No. 64,287

JMG/CDN
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550